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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/725,149

**Applicant(s)**

NAKATSUYAMA, TAKASHI

**Examiner**

JUN FEI ZHONG

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an Amendment filed 2/3/2009. Claims 1-14 are pending. Claims 15-20 are cancelled. The examiner hereby withdraws the rejections of claims 15-20 under 35 USC 112, in light of the amendment.

### ***Response to Arguments***

2. Applicant's arguments filed 2/3/2009 have been fully considered but they are not persuasive.

First, the limitation "only" recites only in the preamble of claim 1 and does not recite in claims 7 and 14.

In response to applicant's arguments, the recitation "only designated information" has not been given patentable weight because the recitation occurs in the preamble of claim 1. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Further, Hendricks discloses using a 4-bit address or a 16-bit set top terminal identifier in the information signal 276 sends from headend to set top

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terminal. And the information signal 276 is designated to specify set top terminal only (see col. 20, line 50-col. 21, line 15).

Second, the information signal designated to each set top terminal must be detected by the set top terminal in order for each set top terminal to download/receive the information and program (e.g., PPV information or program) (see col.6, lines 55-60; col. 10, line 57-67; col. 19, lines 31-45).

Thus, Hendricks discloses the claimed limitation and applicant's arguments are not persuasive.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 6, 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hendricks et al. (patent # US 5659350).

As to claim 1, Hendricks discloses a method for receiving in a broadcast system, at a receiver having a unique identification number (e.g., set top ID 928; Fig. 6a), only designated information (e.g., program control information 276 sends to particular set top box)(see column 17, lines 58-60; column 20, lines 50-58; Fig. 6a), the method comprising the steps of:

monitoring a broadcast index signal (e.g., program control information signal) containing tuning data (e.g., program control information signal contains event ID, global channel ID) (i.e., set top terminal monitoring program control information signals in order to receive program control information signals designated to the set top terminal (program control information contain a set top ID)) (see column 9, lines 42-60; column 17, lines 50-60; column 19, lines 30-41; column 20, lines 50-58; Fig. 6a);

detecting the unique identification number (e.g., set top ID 928; Fig. 6a) associated with the receiver and/or transceiver in the broadcast index signal (i.e., set top terminal detecting program control information signals contain the set top terminal's ID or headend sends program control information 276 to a particular set top terminal) (see column 17, lines 28-60; col. 20, line 50-col. 21, line 15);

downloading the tuning data subsequent to detecting the unique identification number in the detecting step (e.g., download event data matches it's set top ID)(see col. 19, lines 31-45);

storing the downloaded tuning data in memory (e.g., set top terminal 220 stores program control information)(see column 20, lines 22-40);

tuning and receiving a program signal containing program data associated with a program using the tuning data stored in said storing step (see column 11, lines 33-39; col. 37, lines 1-33; col. 38, line63-col. 39, line 9).

As to claim 15, it contains the limitations of claim 1 and is analyzed as previously discussed with respect to claim 1 above.

As to claim 2, Hendricks discloses the method of claim 1, wherein the tuning data includes a reference time at which the program data is broadcast in the program signal, and further comprising the step of: tuning to the program signal at approximately the reference time (see Hendricks incorporated reference patent # US 5734853, col. 36, lines 30-65; Fig. 18).

As to claim 6, Hendricks discloses the method of claim 1, wherein either or both the broadcast index signal and the program signal include data used to present a menu of new programs and/or updates to programs broadcast on the program signal (see col. 3, lines 50-53; col. 20, line 50-col. 21, line 15).

As to claim 16, it contains the limitations of claim 2 and is analyzed as previously discussed with respect to claim 2 above.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 7-9, 11-14, 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hendricks et al. (Patent # US 7134131).

As to claim 7, Hendricks discloses a method for requesting and receiving designated information in a broadcast system, at a transceiver having a unique identification number (e.g., set top ID 928; Fig. 22a) the method comprising the steps of:

transmitting to a wireless communication system (e.g., satellite communication; Fig. 6a) a request signal, the request signal including the unique identification number and a request for a program (e.g., order signal 190) (see col. 10, lines 10-36; col. 21, lines 46-59; col. 13, lines 31-45);

receiving from the wireless communication system a broadcast index signal containing the unique identification number associated with the receiver and tuning data (i.e., set top terminal receiving program control information signals contain the set top terminal's ID, event ID, and global channel ID) (see column 41, line 48-col. 45, line 20);

storing the tuning data in memory (e.g., set top terminal 220 stores program control information) (see column 45, lines 23-41);

receiving a program signal containing program data, associated with a program, using the stored tuning data (see column 7, lines 7-16; col. 33, line 59-col. 34, line 63).

As to claim 14, Hendricks discloses a method for requesting and receiving designated information in a broadcast system, at a first transceiver having a unique identification number (e.g., set top ID 928; Fig. 22a), the method comprising the steps of:

transmitting from the first transceiver (e.g., set top terminal) to a wireless communication system a request signal, the request signal including the unique identification number and a request for a program (e.g., transmitting order signal 190 via satellite communication; Fig. 6a) (see col. 10, lines 10-36; col. 21, lines 46-59; col. 13, lines 31-45);

receiving at the first transceiver, from the wireless communication system, a broadcast index signal containing tuning data (i.e., set top terminal receiving program control information signals contain the set top terminal's ID, event ID, and global channel ID) (see column 41, line 48-col. 45, line 20);

storing the tuning data in memory (e.g., set top terminal 220 stores program control information)(see column 45, lines 23-41);

receiving a program signal containing program data, associated with a program, using the stored tuning data (see column 7, lines 7-16; col. 33, line 59-col. 34, line 63);

transmitting at least a portion of the stored tuning data from the first transceiver to a second transceiver (e.g., transmitting polling response from set top terminal to network controller 214; Fig. 22b) (see col. 46, lines 28-59).



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As to claim 17, it contains the limitations of claim 7 and is analyzed as previously discussed with respect to claim 7 above.

As to claim 20, it contains the limitations of claim 14 and is analyzed as previously discussed with respect to claim 14 above.

As to claim 8, Hendricks discloses the method of claim 7 wherein either or both of the broadcast index signal and the program signal include data, representing new programs and/or updates to programs broadcast on the program signal, the method further comprising the step of: presenting a menu of program choices to a user on a display (see Fig. 15 a-d; col. 32, line 25-col. 33, line 56).

As to claim 9, Hendricks discloses the method of claim 8, wherein the request signal transmitted in said transmitting step is associated with a selection by the user from the menu of program choices (see col. 33, lines 40-56; Fig. 15d).

As to claim 11, Hendricks discloses the method of claim 7 further comprising the steps of: outputting an order form on a display and transmitting an order associated with the order form for goods and/or services (see col. 32, line 55-col. 33, line 29; Fig. 15b).

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As to claim 12, Hendricks discloses the method of claim 11 further comprising the step of outputting an invoice on the display (i.e., the price for each program in Fig. 15d).

As to claim 13, Hendricks discloses the method of claim 8, further comprising the step of transmitting a payment by the user (see col. 18, line 64-col. 19, line 8).

As to claims 18-19, they contain the limitations of claims 8-9 and are analyzed as previously discussed with respect to claims 8-9 above.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (patent # US 5659350) in view of Wannemacher et al. (US Patent Number 6,178,447).

As to claim 3, Hendricks discloses everything as claimed above (see claim 1).

Hendricks discloses configuring the receiver to operate in at least a first state during which the receiver monitors the index signal just prior to the tuning time (e.g., operating set top terminal normally),

However, Hendricks does not disclose a second state during which the receiver does not monitor the index signal.

In an analogous art, Wannenmacher discloses a receiver to operate in a second state (e.g. power save mode) during which the receiver does not monitor the index signal (see column 5, lines 1-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify Hendricks' invention to include a second state which would not monitor the index signal for the predictable result of saving power and energy costs because monitoring a signal continuously consumes more power.

As to claim 4, Wannenmacher discloses causing the receiver to enter a power saving mode during at least a portion of the second state (e.g. power save mode) (see column 5, lines 1-39).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (patent # US 5659350) in view of Barrett et al. (US Patent Number 6,005,597).

As to claim 5, Hendricks discloses everything as claimed above (see claim 1).

However, Hendricks does not disclose outputting a foreground program upon receiver power-on, and outputting a background program subsequent to the user selecting the background program for output.

In an analogous art, Barrett discloses outputting a foreground program upon receiver power-on, and outputting a background program subsequent to the user selecting the background program for output (see column 4, lines 15-23).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify Hendricks' invention to include a default foreground program when turning the receiver on, and a outputting a background program when the user selects that program for the predictable result of simplifying a user's preferences and displaying the program the user wishes to see.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (patent # US 7134131) in view of Barrett et al. (US Patent Number 6,005,597).

As to claim 10, Hendricks discloses everything as claimed above (see claim 7).

However, Hendricks does not disclose outputting a foreground program upon receiver power-on, and outputting a background program subsequent to the user selecting the background program for output.

In an analogous art, Barrett discloses outputting a foreground program upon receiver power-on, and outputting a background program subsequent to the user selecting the background program for output (see column 4, lines 15-23).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify Hendricks' invention to include a default foreground program when turning the receiver on, and a outputting a background program when the user selects that program for the predictable result of simplifying a user's preferences and displaying the program the user wishes to see.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUN FEI ZHONG whose telephone number is (571)270-1708. The examiner can normally be reached on Mon-Fri, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JFZ

5/5/2009

/VIVEK SRIVASTAVA/

Supervisory Patent Examiner, Art Unit 2426